

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

EX PARTE JONATHAN J. OLIVER ET AL.

APPLICATION NO. 10/650,487

FILING DATE: AUGUST 27, 2003

REPLY BRIEF UNDER 37 C.F.R. § 41.41

CARR & FERRELL *LLP*
2200 GENG ROAD
PALO ALTO, CA 94303
T: 650.812.3400
F: 650.812.3444

ATTORNEY FOR THE APPELLANT
AND REAL-PARTY-IN-INTEREST

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STATUS OF THE CLAIMS
(37 C.F.R. § 41.37(C)(1)(iii))

Independent claims 1, 20, 23, 24, 28, 29, 30, and 31 are pending. Dependent claims 2, 5-19, 22, and 25-27 are likewise pending and dependent (either directly or via an intermediate dependent claim) upon one of the aforementioned independent claims. Claims 3, 4, and 21 have been canceled. The Appellants previously stated that they “have elected to appeal only the rejection of independent claims 1, 20, 23, 24, 28, 29, 30, and 31” and that said election was “made for purposes of administrative efficiency of the Board of Patent Appeals and Interferences and to maintain the focus and clarity of argument.” *AMENDED BRIEF ON APPEAL*, 4.

The Appellants clarify that statement in that the rejection of *all claims is appealed*. The Appellants have, however, elected to *address in detail* only the rejection of independent claims 1, 20, 23, 24, 28, 29, 30, and 31. To the extent that the Appellants contend any one of the aforementioned independent claims to be allowable, the related chain of dependent claims is allowable for at least the same reason as the independent claim from which it depends. The Appellants provide this clarification in order to avoid giving rise to any presumption addressed in the matter of *Ex Parte Ghuman et al.* (2008-1175) (May 1, 2008). This election, again, should not be construed as a concurrence as to the basis for the rejection for any claim of the ‘487 Application.

ARGUMENT
(37 C.F.R. § 41.37(C)(1)(vii))

The Examiner continues to assert that increasing the confidence ratio “to a relative high value” is equivalent to a “zero percent erroneous classification probability.” *EXAMINER’S ANSWER*, 9-10. Again, there is no indication in *Chasin* that the erroneous classification probability *is* less than 1% and to suggest the same would be an unsupported extrapolation of the purported teachings of *Chasin*. See *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993) (finding that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic); see also *In re Robertson*, 169 F.3d 743, 745 (stating that “[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is **necessarily present** in the thing described in the reference’ as “[i]nherency . . . may not be established by probabilities or possibilities”) (emphasis added).

Chasin states that confidence ratio **may be** higher than 95 percent; the fact that the ratio **may be** higher than 95 percent does not mean that that the corresponding error classification **is** less than 1%. Again, a confidence level of 96% would correspond to the description provided in *Chasin* but would not meet the presently claimed limitation of an erroneous classification level of less than 1%. As such, the Examiner’s rejection should be overturned.

CONCLUSION AND REQUESTED RELIEF

Each of the independent claims of the present application require a classifier having or capable of having an erroneous classification probability of less than one percent. U.S. Patent Publication Number 2005/0015626 to *Chasin* fails to disclose an erroneous classification probability of less than one percent, especially with 'sufficient specificity' as is required by law. Further, an erroneous classification probability of less than one percent is not 'necessarily present' in *Chasin*, thus a rejection based on inherency is inappropriate. In light of the aforementioned, and the fact that *Andrews et al.* also fails to disclose an erroneous classification probability, much less one that is less than 1% per the Appellants' independent claims, the Examiner has failed to evidence a *prima facie* case of obviousness and the 35 U.S.C. § 103(a) rejection is overcome.

The Appellants, therefore, respectfully request that the final rejection be overturned and the present application remanded with instructions to allow the same.

Respectfully submitted,
Jonathan J. Oliver et al.

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By: /Tam Thanh Pham/
TAM THANH PHAM, REG. NO. 50,565
CARR & FERRELL LLP
2200 GENG ROAD
PALO ALTO, CA 94303
T: 650.812.3400
F: 650.812.3444

ATTORNEY FOR THE APPELLANT
AND REAL-PARTY-IN-INTEREST